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** Pro hac vice application forthcoming*

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16 **UNITED STATES DISTRICT COURT**
17 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
18 **SAN JOSE DIVISION**

19
20 APPLE INC., CISCO SYSTEMS, INC.,
21 GOOGLE LLC, and INTEL CORPORATION,

22 Plaintiffs,

23 v.

24 ANDREI IANCU, in his official capacity as
25 Under Secretary of Commerce for Intellectual
26 Property and Director, United States Patent and
27 Trademark Office,

28 Defendant.

Case No.: 5:20-cv-6128

**COMPLAINT FOR DECLARATORY
AND INJUNCTIVE RELIEF**

Administrative Procedure Act Case

INTRODUCTION

1
2 1. This action under the Administrative Procedure Act (“APA”) challenges a rule
3 adopted by the Director of the U.S. Patent and Trademark Office (“PTO”) governing that agency’s
4 consideration of petitions to institute inter partes review (“IPR”)—an administrative proceeding for
5 determining the patentability of previously issued patent claims.

6 2. A strong patent system is vital to protecting the massive research and development
7 investments that fuel Plaintiffs’ innovative products and services. And a crucial element of any
8 strong patent system is a mechanism for “weeding out” weak patents that never should have been
9 granted because the claimed invention was not novel or would have been obvious in light of prior art.
10 *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1374 (2020). Such patents threaten
11 innovation—particularly in the hands of non-practicing entities that use the patent system not to spur
12 their own inventions, but to extract monetary returns by asserting weak patents in infringement suits.
13 As frequent targets of such tactics, Plaintiffs have a strong interest in having an efficient and
14 accessible means for challenging weak patents that should never have issued to ensure that such
15 patents cannot hamper innovation.

16 3. IPR was a centerpiece of Congress’s efforts to strengthen the U.S. patent system in the
17 Leahy-Smith America Invents Act (“AIA”). In enacting the AIA in 2011, Congress recognized that
18 innovation is inhibited when invalid patents are issued and then deployed in litigation against
19 technology inventors and developers. And Congress found existing procedures for challenging
20 already-issued patents, including litigation, to be insufficient to protect the patent system. Congress
21 accordingly created IPR to provide a more efficient and streamlined administrative alternative to
22 litigation for determining patentability before specialized patent judges. IPR has served to enhance
23 the U.S. patent system and strengthen U.S. technology and innovation by weeding out thousands of
24 invalid patent claims.

25 4. To ensure that IPR fulfills its purpose as a superior alternative to litigation over patent
26 validity, the AIA specifically contemplates that IPR will be available to determine the patentability of
27 patent claims that are also the subject of pending patent infringement litigation.
28

1 5. In the agency action challenged in this suit (referred to here as the “*NHK-Fintiv* rule”),
2 however, the Director determined that the PTO could deny a petition for IPR based on a balancing of
3 discretionary factors relating to the pendency of parallel patent infringement litigation—factors that
4 appear nowhere in the AIA. The agency’s application of that rule has dramatically reduced the
5 availability of IPR, regardless of the weakness of the patent claims being challenged, thereby
6 undermining IPR’s central role in protecting a strong patent system.

7 6. The *NHK-Fintiv* rule violates the AIA, which allows IPR to proceed in tandem with
8 infringement litigation involving the same patent claims so long as the IPR petition is filed within one
9 year after the petitioner was served with the complaint in the infringement suit. Congress dictated in
10 the AIA exactly when litigation should take precedence over IPR and vice versa, and the *NHK-Fintiv*
11 rule contravenes Congress’s judgment. Indeed, the *NHK-Fintiv* rule defeats the purpose of IPR,
12 which is to provide a streamlined and specialized mechanism for clearing away invalid patents that
13 never should have issued, and to do so without the substantial costs, burdens, and delays of litigation.

14 7. The *NHK-Fintiv* rule is also arbitrary and capricious because its vague factors lead to
15 speculative, unpredictable, and unfair outcomes and will not advance the agency’s stated goal of
16 promoting administrative efficiency.

17 8. Finally, even if it were not contrary to law, the *NHK-Fintiv* rule is procedurally invalid
18 because it was not adopted through notice-and-comment rulemaking. Both the APA and the AIA
19 obligated the Director to follow that procedure, yet the Director instead propounded the *NHK-Fintiv*
20 rule through an internal process within the PTO for establishing binding rules by designating select
21 decisions of the Patent Trial and Appeal Board as “precedential”—a process that provides for no
22 opportunity for or consideration of public input.

23 9. The Court should therefore declare the *NHK-Fintiv* rule unlawful and set it aside under
24 the APA. The Court should further permanently enjoin the Director from applying the rule or the
25 non-statutory factors it incorporates to deny institution of IPR.

JURISDICTION AND VENUE

10. This case arises under the Administrative Procedure Act (“APA”), 5 U.S.C. § 701 *et seq.* This Court has subject matter jurisdiction under 28 U.S.C. § 1331.

11. Pursuant to 5 U.S.C. § 702, Defendant has waived sovereign immunity for purposes of this suit.

12. Plaintiffs’ claims for declaratory and injunctive relief are authorized by 28 U.S.C. §§ 2201 and 2202, by 5 U.S.C. §§ 702-706, by Federal Rules of Civil Procedure 57 and 65, and by the inherent equitable powers of this Court.

13. Venue is proper in this District under 28 U.S.C. § 1391(e) and 5 U.S.C. § 703 because at least one Plaintiff maintains its headquarters in this District.

14. The *NHK-Fintiv* rule is final agency action subject to judicial review under 5 U.S.C. § 704.

INTRADISTRICT ASSIGNMENT

15. This action arises in the San Jose Division because a substantial part of the events giving rise to Plaintiffs’ claims occurred in Santa Clara County, California, where all Plaintiffs maintain their headquarters.

PARTIES

16. Plaintiff Apple Inc. (“Apple”) is a California corporation having its principal place of business at One Apple Park Way, Cupertino, California, 95014.

17. Plaintiff Cisco Systems, Inc. (“Cisco”) is a California corporation having its principal place of business at 170 West Tasman Drive, San Jose, California, 95134.

18. Plaintiff Google LLC (“Google”) is a Delaware limited liability company having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California, 94043.

19. Plaintiff Intel Corporation (“Intel”) is a Delaware corporation having its principal place of business at 2200 Mission College Boulevard, Santa Clara, California, 95054.

20. Defendant Andrei Iancu is the Under Secretary of Commerce for Intellectual Property and Director of the PTO. The Director oversees the operations of the PTO and is statutorily vested

1 with the authority to decide whether to institute IPR of a patent claim. 35 U.S.C. § 314. Defendant
2 Iancu is being sued in his official capacity. His principal place of business is in Alexandria, Virginia.

3 **FACTUAL ALLEGATIONS**

4 **The Patent System**

5 21. “To promote the progress of science and useful arts,” the Constitution empowers
6 Congress to “secur[e] for limited times to ... inventors the exclusive right to their ... discoveries.”
7 U.S. Const., art. I, § 8, cl. 8. The U.S. patent system has long fueled American economic growth and
8 innovation. Plaintiffs each strongly support and rely on a strong patent system that lends robust legal
9 protection to meritorious patent claims.

10 22. Apple is an American success story and developer of iconic consumer devices and
11 software that have transformed the American economy. With more than 90,000 employees in the
12 United States, Apple is one of the country’s largest employers in the high-technology business sector.
13 Overall, Apple supports 2.4 million jobs in all 50 states. Last year, Apple spent over \$60 billion with
14 more than 9,000 domestic suppliers across the country, including at manufacturing locations in 36
15 states. Apple invests billions of dollars annually in U.S. research and development, and it owns more
16 than 22,000 U.S. patents that protect that investment.

17 23. Cisco is an American and worldwide leader in information technology, networking,
18 communications, and cybersecurity solutions. Cisco is a strong supporter of the U.S. patent system,
19 owning more than 16,000 U.S. patents, which protect more than \$6 billion in annual spending on
20 research and development. Cisco’s 20,000 worldwide engineers constantly invent new ways to better
21 connect the world. As a result of its commitment to innovation and intellectual property, Cisco files
22 more than 700 patent applications each year seeking protection for those inventions.

23 24. Google is a diversified American technology company whose mission is to organize
24 the world’s information and make it universally accessible and useful. Google offers leading web-
25 based products and services that are used daily around the world. With over 100,000 employees,
26 Google invests over \$20 billion annually to invent and develop its products and services, and it relies
27 on a strong and balanced patent system to protect them—owning more than 25,000 U.S. patents.

1 29. Several features of IPR make it advantageous compared to litigation for determining
2 whether an issued patent’s claims are patentable. IPR is conducted by the expert patent judges of the
3 Patent Trial and Appeal Board (“Board”), who are appointed by the Secretary of Commerce and must
4 be “persons of competent legal knowledge and scientific ability.” 35 U.S.C. § 6(a), (c). In contrast,
5 patent validity disputes in court are resolved by lay jurors who need not have—and often lack—any
6 specialized technical experience relevant to the patent claims at issue. Moreover, unlike jury trials,
7 which typically end in general verdicts, IPR ends with the Board’s “final written decision,” *id.*
8 § 318(a), which enables more informed appellate review. And while bad patents can be held
9 unpatentable in IPR by a preponderance of the evidence, *id.* § 316(e), those same patents will survive
10 litigation unless the challenger proves invalidity by clear and convincing evidence, *see Microsoft*
11 *Corp. v. i4i Ltd. P’ship*, 564 U.S. 91 (2011).

12 30. IPR is also more streamlined and efficient than litigation. An IPR petitioner may
13 challenge a claim’s patentability only on limited grounds. 35 U.S.C. § 311(b). The scope of
14 discovery in IPR proceedings is more limited than in civil litigation. *See id.* § 316(a)(5); 37 C.F.R.
15 § 42.51. The AIA also limits how long the Director may take to decide whether to institute IPR, 35
16 U.S.C. § 314(b), and, if IPR is instituted, how long the Board may take to issue its final decision on
17 patentability, *id.* § 316(a)(11). As a result, the life-span of an IPR from the filing of a petition to a
18 final written decision is typically only 18 months. *See id.* § 316(a)(11); 37 C.F.R. § 42.107.

19 **The Availability Of IPR In Parallel With Infringement Actions**

20 31. Given its purpose to provide an efficient alternative to litigation, Congress expected
21 that IPR would often proceed in parallel with litigation in which the validity of the same patent
22 claims is at issue—particularly in cases where a defendant accused of patent infringement in a lawsuit
23 seeks to challenge the asserted patent claims through IPR. Several provisions of the AIA reflect that
24 expectation and govern the interaction between IPR and litigation.

25 32. The AIA permits a party accused of infringement to file a petition for IPR with regard
26 to the same patent claims that are being asserted in the pending infringement suit, so long as the
27 petition is filed within “1 year after the date on which the petitioner ... is served with a complaint
28

1 alleging infringement of the patent.” 35 U.S.C. § 315(b). And although the AIA forecloses IPR if
2 the petitioner has previously “filed a civil action challenging the validity of a claim of the patent,” *id.*
3 § 315(a)(1), it expressly permits a petitioner to assert invalidity arguments in a counterclaim in
4 litigation without forgoing IPR, *id.* § 315(a)(3).

5 33. The AIA also removed statutory provisions that previously restricted the PTO’s
6 review of patent claims that had been the subject of a challenge to the patent’s validity in district
7 court. Before the creation of IPR, parties could challenge issued patents pursuant to an administrative
8 procedure known as inter partes reexamination, but no such review could be maintained if a court
9 entered “a final decision” concluding that the petitioner “ha[d] not sustained its burden of proving the
10 invalidity” of the patent. 35 U.S.C. § 317(b) (2006). The AIA eliminated that rule and imposed no
11 similar limitation on IPR, which replaced inter partes reexamination.

12 34. Apart from the one-year deadline in § 315(b), and the prohibition in § 315(a)(1) on
13 filing an IPR petition after filing a suit challenging patent validity, no provision in the AIA expressly
14 requires or even permits the Director (or the Board as his delegee) to deny IPR petitions based on
15 pending litigation involving the same patent claims.

16 The *NHK* And *Fintiv* Decisions

17 35. The AIA specifies several requirements that must be met for the Director of the PTO
18 to grant a petition for, or “institute,” IPR, and enumerates discretionary grounds on which the
19 Director may decline to institute IPR even if those preconditions are met. *E.g.*, 35 U.S.C.
20 §§ 311(c)(1)-(2), 312(a)(1)-(5), 315(a)(1)-(2). For example, the Director “may not” institute IPR
21 “unless” he determines, based on the IPR petition, that “there is a reasonable likelihood that the
22 petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” *Id.*
23 § 314(a). And the Director “may take into account whether, and reject the petition or request
24 because, the same or substantially the same prior art or arguments previously were presented to the
25 [Patent] Office.” *Id.* § 325(d).

26 36. The Director has delegated to the Board the authority to decide whether to institute
27 IPR. 37 C.F.R. § 42.4(a); *see id.* §§ 42.2, 42.108.

1 37. In two recent decisions, the Board articulated an additional standard, found nowhere in
2 the AIA, under which the Board may decline to institute IPR based on the pendency of litigation over
3 the validity of the same patent claims—even if the petition was timely filed within the one-year
4 deadline set by 35 U.S.C. § 315(b).

5 38. In *NHK Spring Co. v. Intri-Plex Technologies, Inc.*, the Board declared that “the
6 advanced state of [a parallel] district court proceeding ... weighs in favor of denying the [IPR]
7 Petition under § 314(a).” No. IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (attached
8 hereto as Ex. A; also available at 2018 WL 4373643).

9 39. The Board explained in *NHK* that because a pending infringement lawsuit involving
10 “the same prior art and arguments” as the IPR petition was “nearing its final stages,” with trial “set to
11 begin” about six months before the IPR would end, IPR “would not be consistent with an objective of
12 the AIA ... to provide an effective and efficient alternative to district court litigation.” *NHK*, Paper 8
13 at 20 (internal quotation marks omitted).

14 40. In *Apple Inc. v. Fintiv, Inc.*, the Board elaborated on *NHK*, explaining how it would
15 consider the pendency of a parallel infringement lawsuit when deciding whether to institute IPR. No.
16 IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (attached hereto as Ex. B; also available at 2020
17 WL 2126495). The Board declared it would “weigh[]” various “non-dispositive factors” to decide
18 whether to institute IPR when parallel litigation is pending “as part of a balanced assessment of all
19 relevant circumstances of the case, including the merits,” to promote “system efficiency, fairness, and
20 patent quality.” *Id.* at 5 (internal quotation marks omitted).

21 41. Accordingly, the Board enumerated six such “factors,” none of which appears in the
22 AIA:

- 23 1. whether the court granted a stay or evidence exists that one may be
24 granted if [an IPR] proceeding is instituted;
- 25 2. proximity of the court’s trial date to the Board’s projected statutory
26 deadline for a final written decision;
- 27 3. investment in the parallel proceeding by the court and the parties;

- 1 4. overlap between issues raised in the petition and in the parallel
- 2 proceeding;
- 3 5. whether the petitioner and the defendant in the parallel proceeding are
- 4 the same party; and
- 5 6. other circumstances that impact the Board’s exercise of discretion,
- 6 including the merits.

7 *Fintiv*, Paper 11 at 5-6.

8 42. Although the Board offered general guidance on how it might apply some of these
9 factors, the *Fintiv* decision did not clearly “instruct [the Board] how to weigh the factors.” *Cisco*
10 *Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, No. IPR2020-00122, 2020 WL 2511246, at *5 (P.T.A.B.
11 May 15, 2020) (Crumbley, APJ, dissenting).

12 **Designation Of The Board’s Decisions As Precedential**

13 43. “[B]y default,” the Board’s decisions in IPR proceedings have no precedential force in
14 future cases. Patent Trial and Appeal Board, Standard Operating Procedure 2 (Rev. 10) (“SOP-2”), at
15 3, 8-9 (Sept. 20, 2018).

16 44. The PTO, however, has established a procedure for designating select Board decisions
17 as “precedential.” SOP-2 at 1-2, 8-12. Decisions designated as precedential are “binding” on the
18 Board “in subsequent matters involving similar factors or issues.” SOP-2 at 11.

19 45. Under this procedure, the Director decides whether to designate a Board decision as
20 precedential. SOP-2 at 11.

21 46. Although members of the public (in addition to members of the Board) may nominate
22 a Board decision for designation as precedential, SOP-2 at 9, the designation procedure otherwise
23 does not allow for public notice of, or any opportunity for public comment on, whether a Board
24 decision should be designated as precedential. SOP-2 at 8-11.

25 47. The Director designated *NHK* as precedential on May 7, 2019.

26 48. The Director designated *Fintiv* as precedential on May 5, 2020.

1 49. By designating these decisions as precedential, the Director propounded a rule (the
2 “*NHK-Fintiv* rule”) that the Board is legally bound to apply in all its institution decisions.

3 50. The Director adopted the *NHK-Fintiv* rule without notice-and-comment rulemaking.

4 51. Having been established as a binding rule through the designation of the *NHK* and
5 *Fintiv* decisions as precedential, the *NHK-Fintiv* rule constitutes final agency action.

6 **The Board’s Application Of The *NHK-Fintiv* Rule**

7 52. The Board has applied the *NHK-Fintiv* rule to deny institution of numerous IPR
8 proceedings, including many petitions brought by Plaintiffs.

9 53. Following *NHK*, the Board relied on that decision to deny several IPR petitions. *See*
10 *Edwards Lifesciences Corp. v. Evalve, Inc.*, No. IPR2019-01546, 2020 WL 1486766 (P.T.A.B. Mar.
11 19, 2020); *Edwards Lifesciences Corp. v. Evalve, Inc.*, No. IPR2019-01479, 2020 WL 927867
12 (P.T.A.B. Feb. 26, 2020); *Magellan Midstream Partners L.P. v. Sunoco Partners Marketing &*
13 *Terminals L.P.*, No. IPR2019-01445, 2020 WL 373335 (P.T.A.B. Jan. 22, 2020); *Next Caller Inc. v.*
14 *TRUSTID, Inc.*, No. IPR2019-00962, 2019 WL 5232627 (P.T.A.B. Oct. 16, 2019); *Next Caller Inc. v.*
15 *TRUSTID, Inc.*, No. IPR2019-00961, 2019 WL 5232627 (P.T.A.B. Oct. 16, 2019).

16 54. For example, on March 27, 2020, the Board denied institution in *Google LLC v.*
17 *Uniloc 2017, LLC*, No. IPR2020-00115, 2020 WL 1523248 (Mar. 27, 2020). Although Google
18 timely filed the IPR petition in that proceeding less than nine months after being served with a related
19 infringement complaint, the Board denied the petition under *NHK* based on the trial date set in the
20 district court’s scheduling order. *Id.* at *1, *4. Google requested rehearing, but its request was
21 denied. Soon thereafter, the district court action was ordered to be transferred, and the trial date was
22 vacated. *Uniloc 2017, LLC v. Google LLC*, No. 18-cv-00504, 2020 WL 3064460, at *6 (E.D. Tex.
23 June 8, 2020).

24 55. On the same day that *Fintiv* was designated as precedential, the Board applied the
25 *NHK-Fintiv* rule to deny Intel’s IPR petition in *Intel Corp. v. VLSI Technology LLC*, No. IPR2020-
26 00106, 2020 WL 2201828 (P.T.A.B. May 5, 2020). The petition had been timely filed, but the Board
27 concluded that the “advanced stage” of related district court litigation, overlap in the issues, and the
28

1 timing of trial—which was scheduled to begin approximately seven months before IPR would have
2 ended, but which was subsequently rescheduled—meant that IPR would have been “an inefficient use
3 of Board, party, and judicial resources.” *Id.* at *6.

4 56. Eight days later, the Board applied the *NHK-Fintiv* rule to deny Apple’s IPR petition
5 in *Fintiv*. *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2486683, at *3-4, *7 (P.T.A.B.
6 May 13, 2020) (Paper 15). In *Fintiv*, Apple had filed an IPR petition challenging the patentability of
7 certain patent claims that had been asserted against Apple in a patent infringement suit. Apple timely
8 filed the IPR petition less than ten months after the infringement suit began. After Apple filed its IPR
9 petition, the district court in the infringement lawsuit held a *Markman* hearing (to consider evidence
10 relevant to the interpretation of the patent claims) and then set a trial date, which it later rescheduled.
11 *Id.* at *3-4, *7. In declining to institute IPR, the Board explained that

12 the District Court case is ongoing, trial is scheduled to begin two months before
13 we would reach a final decision in this proceeding, the District Court has
14 expended effort resolving substantive issues in the case, the identical claims are
15 challenged based on the same prior art in both the Petition and in the District
16 Court, and the defendant in District Court and the Petitioner here are the same
17 party.

18 *Id.* at *7.

19 57. The Board subsequently applied the *NHK-Fintiv* rule to deny IPR petitions filed five
20 months after service of the complaint in the pending infringement action in *Cisco Systems, Inc. v.*
21 *Ramot at Tel Aviv University Ltd.* No. IPR2020-00122, 2020 WL 2511246 (P.T.A.B. May 15, 2020);
22 No. IPR2020-00123, 2020 WL 2511247 (P.T.A.B. May 15, 2020). Based on the scheduled trial date
23 in pending infringement litigation, overlap in substantive issues, and the absence of a stay in the
24 district court, the Board assumed that proceeding with IPR would “duplicate effort” in the litigation,
25 *Ramot*, No. IPR2020-00122, 2020 WL 2511246, at *4—even though the district court had denied a
26 stay “without prejudice” in light of its “established practice” to entertain stay requests only *after* the
27 Board institutes IPR, *id.* at *3—and denied Cisco’s IPR petitions to avoid “an inefficient use of
28 Board, party, and judicial resources,” *id.* at *5; *see also Ramot*, No. IPR2020-00123, 2020 WL
2511247, at *5.

1 58. Indeed, since the *NHK* and *Fintiv* decisions' designation as precedential, the Board has
2 applied the *NHK-Fintiv* rule to deny IPR petitions filed by Plaintiffs and others on numerous
3 occasions. *See, e.g., Apple Inc. v. Maxell, Ltd.*, No. IPR2020-00407, 2020 WL 4680039 (P.T.A.B.
4 Aug. 11, 2020); *Apple Inc. v. Maxell, Ltd.*, No. IPR2020-00408, 2020 WL 4680042 (P.T.A.B. Aug.
5 11, 2020); *Apple Inc. v. Maxell, Ltd.*, No. IPR2020-00409, 2020 WL 4680047 (P.T.A.B. Aug. 11,
6 2020); *Apple Inc. v. Maxell, Ltd.*, No. IPR2020-00203, 2020 WL 3662522 (P.T.A.B. July 6, 2020);
7 *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, No. IPR2020-00484, 2020 WL 4820592 (P.T.A.B.
8 Aug. 18, 2020); *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, No. IPR2020-00122, 2020 WL
9 2511246 (P.T.A.B. May 15, 2020); *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, No. IPR2020-
10 00123, 2020 WL 2511247 (P.T.A.B. May 15, 2020); *Ethicon, Inc. v. Bd. of Regents, Univ. of Tex.*
11 *Sys.*, No. IPR2019-00406, 2020 WL 3088846 (P.T.A.B. June 10, 2020); *Google LLC v. Uniloc 2017,*
12 *LLC*, No. IPR2020-00115, 2020 WL 1523248 (P.T.A.B. Mar. 27, 2020); *Intel Corp. v. VLSI Tech.*
13 *LLC*, No. IPR2020-00498, 2020 WL 4820595 (P.T.A.B. Aug. 19, 2020); *Intel Corp. v. VLSI Tech.*
14 *LLC*, No. IPR2020-00526, 2020 WL 4820610 (P.T.A.B. Aug. 18, 2020); *Intel Corp. v. VLSI Tech.*
15 *LLC*, No. IPR2020-00527, 2020 WL 4820610 (P.T.A.B. Aug. 18, 2020); *Intel Corp. v. VLSI Tech.*
16 *LLC*, No. IPR2020-00141, 2020 WL 3033208 (P.T.A.B. June 4, 2020); *Intel Corp. v. VLSI Tech.*
17 *LLC*, No. IPR2020-00142, 2020 WL 3033209 (P.T.A.B. June 4, 2020); *Intel Corp. v. VLSI Tech.*
18 *LLC*, No. IPR2020-00158, 2020 WL 2563448 (P.T.A.B. May 20, 2020); *Intel Corp. v. VLSI Tech.*
19 *LLC*, No. IPR2020-00112, 2020 WL 2544910 (P.T.A.B. May 19, 2020); *Intel Corp. v. VLSI Tech.*
20 *LLC*, No. IPR2020-00113, 2020 WL 2544912 (P.T.A.B. May 19, 2020); *Intel Corp. v. VLSI Tech.*
21 *LLC*, No. IPR2020-00114, 2020 WL 2544917 (P.T.A.B. May 19, 2020).

22 59. Plaintiffs are currently awaiting institution decisions on IPR petitions that relate to
23 pending infringement litigation, in which the Board will be bound to apply the *NHK-Fintiv* rule to
24 decide whether to institute IPR. Additionally, Plaintiffs regularly file IPR petitions and expect that
25 the Board will apply the *NHK-Fintiv* rule to decide whether to grant their future petitions when
26 parallel litigation is pending. The Board is likely to deny at least some of Plaintiffs' pending or
27 future IPR petitions under the *NHK-Fintiv* rule based on the pendency of litigation.

1 60. Even where the Board has decided to institute IPR under the *NHK-Fintiv* rule, its
2 decisions have been inconsistent and unpredictable, making it difficult for Plaintiffs to anticipate how
3 the Board will weigh and apply each factor. The rule also forces petitioners to file IPR petitions at
4 earlier stages of litigation when there is less certainty over the patent claims at issue and their scope.

5 **The *NHK-Fintiv* Rule Exceeds The Director’s Authority And Violates The AIA**

6 61. Nothing in the AIA authorizes the Director to deny IPR petitions based on perceived
7 overlap with pending infringement litigation involving the same patent claims. To the contrary, the
8 text and structure of the AIA make clear that IPR can and should proceed even where related
9 litigation is pending.

10 62. Most notably, the AIA permits IPR if the petition is filed within “1 year after the date
11 on which the petitioner ... is served with a complaint alleging infringement of the patent.” 35 U.S.C.
12 § 315(b). Congress thus explicitly determined that, so long as the IPR petition is filed within a year
13 after a lawsuit against the petitioner starts, IPR is appropriate.

14 63. Congress’s decision to allow IPR where a parallel infringement lawsuit has been
15 pending for less than one year reflects its considered policy judgment. In enacting the AIA, Congress
16 was aware that IPR and litigation concerning the same patent claim would often proceed in parallel,
17 and it carefully calibrated § 315(b)’s one-year limit to ensure that IPR is not used for purposes of
18 delay while also giving infringement defendants an adequate opportunity to investigate the claims
19 asserted against them in litigation. Similarly, while Congress prohibited IPR where a petitioner had
20 previously filed its own action challenging patent validity, *see* 35 U.S.C. § 315(a)(1), Congress
21 expressly declined to extend that prohibition to petitions where the petitioner challenged the patent’s
22 validity through a counterclaim, *see id.* § 315(a)(3).

23 64. By authorizing the Board to deny institution of IPR based on the pendency of a
24 parallel proceeding, the *NHK-Fintiv* rule overrides the congressional judgments embodied in
25 §§ 315(a) and (b).

26 65. The *NHK-Fintiv* rule also undermines the purpose of IPR as a streamlined and
27 specialized alternative to litigation over patent validity. Congress sought in the AIA to encourage
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1 defendants accused of patent infringement in litigation to assert their potentially meritorious
2 challenges to patentability in an IPR petition—thereby *inviting* overlap between IPR and litigation in
3 which the petitioner would assert those same challenges as defenses against an infringement claim.
4 Yet the *NHK-Fintiv* rule threatens to make IPR unavailable in precisely the circumstances where
5 Congress intended it to operate, defeating IPR’s role as a more efficient mechanism for clearing away
6 invalid patents and ultimately weakening the patent system.

7 66. Where Congress wanted to give the Director discretion to deny IPR based on parallel
8 proceedings, it knew how to say so explicitly. For example, as noted, the AIA provides that if the
9 *IPR petitioner* has previously filed suit challenging the validity of a patent claim, IPR may not be
10 instituted at all—regardless of how much time has passed between the suit and the IPR petition. 35
11 U.S.C. § 315(a)(1). Similarly, Congress expressly granted the Director discretion to decide how to
12 manage IPR when there is a parallel proceeding *before the PTO*, including by terminating the IPR
13 proceeding, *id.* § 315(d), and by “reject[ing] the petition or request because[] the same or
14 substantially the same prior art or arguments previously were presented to the [Patent] Office,” *id.*
15 § 325(d). But Congress nowhere authorized denial of a timely IPR petition based on overlap with
16 parallel litigation brought by the patent owner. To the contrary, Congress expressly provided that a
17 petitioner’s counterclaim challenging the validity of a patent claim would not bar IPR. *Id.*
18 § 315(a)(3).

19 67. Although the statute accords the Director some discretion in the context of evaluating
20 the merits of IPR petitions or promulgating rules governing IPR institution, that discretion is limited.
21 *See* 35 U.S.C. §§ 314(a), 316(b). It certainly is not unbounded and cannot be exercised in a manner
22 that is contrary to the statute’s text, structure, and purpose.

23 **The *NHK-Fintiv* Rule Is Arbitrary And Capricious**

24 68. The Board’s application of the *NHK-Fintiv* rule has already led to unjustifiable and
25 unpredictable disparities among similarly-situated IPR petitioners, reflecting the uncertainty and
26 malleability of the rule’s factors.

1 69. The *NHK-Fintiv* rule requires the Board to make institution decisions based on its
2 speculation about the likely course of parallel litigation, producing irrational and inconsistent
3 outcomes. For example, if no stay has been entered in the district court, the Board must guess
4 whether “one may be granted” if IPR is instituted. *Fintiv*, Paper 11 at 6.

5 70. The Board inconsistently applies the second factor, which concerns the proximity of a
6 district court trial date to the Board’s projected statutory deadline for a final written decision. For
7 example, after denying Apple’s petition in *Fintiv* (where trial was scheduled to begin only two
8 months before the Board would have been required to issue a final written decision in an IPR), the
9 Board *instituted* IPR in other cases where the scheduled trial dates fell much earlier relative to the
10 IPR decision deadline. *See, e.g., Apple Inc. v. Maxell, Ltd.*, No. IPR2020-00204, 2020 WL 3401274,
11 at *6 (P.T.A.B. June 19, 2020) (trial scheduled for nine months before Board’s decision deadline);
12 *Apple Inc. v. SEVEN Networks, LLC*, No. IPR2020-00156, 2020 WL 3249313, at *4 (P.T.A.B. June
13 15, 2020) (trial scheduled for 7.5 months before Board’s decision deadline). In another case, the
14 Board declined to institute IPR based on the expected time of trial, even though the trial date had
15 been continued indefinitely. *Ethicon, Inc. v. Bd. of Regents, Univ. of Tex. Sys.*, No. IPR2019-00406,
16 2020 WL 3088846 (P.T.A.B. June 10, 2020).

17 71. The date of trial is an inherently unpredictable factor, given the frequency with which
18 trial dates are rescheduled. The Board even had to grant rehearing of one non-institution decision
19 after the district court rescheduled the trial date following the Board’s decision. *Sand Revolution II,*
20 *LLC v. Continental Intermodal Group – Trucking LLC*, No. IPR2019-01393, 2020 WL 581790
21 (P.T.A.B. June 16, 2020). Rehearing is not an option in most cases, however, because IPR
22 petitioners are allowed only 30 days to seek it, 37 C.F.R. § 42.71(d)(2), and a district court might
23 reschedule trial long after that period has passed. That is precisely what occurred in *Uniloc 2017*,
24 where the Board denied Google’s IPR petition based on a trial date that was subsequently vacated—
25 too late for Google to obtain rehearing of the Board’s denial of the IPR petition. *See* 2020 WL
26 3064460, at *6.

1 72. Similarly, the Board has sometimes concluded that overlap in issues favored
2 institution, while in other cases, the Board has treated overlap as disfavoring institution. For
3 example, in one case, the Board stated that overlap favored institution when the Board thought trial
4 was relatively distant, but in another case decided that overlap disfavored institution when the Board
5 thought trial was near. *Compare Medtronic, Inc., & Medtronic Vascular, Inc. v. Teleflex Innovations*
6 *S.à.r.l.*, No. IPR2020-00135, 2020 WL 3053201 (P.T.A.B. June 8, 2020), *with Cisco Sys., Inc. v.*
7 *Ramot at Tel Aviv Univ. Ltd.*, No. IPR2020-00122, 2020 WL 2511246 (P.T.A.B. May 15, 2020). As
8 a result, some petitioners will succeed in obtaining review of claims that overlap with those in the
9 parallel litigation while others will not, all based on trial schedules that are inherently uncertain and
10 subject to speculative forecasting by the Board.

11 73. The *NHK-Fintiv* rule thus promotes uncertainty and unpredictability—not
12 administrative efficiency—in the IPR process. The rule also forces infringement defendants to file
13 IPR petitions earlier in litigation, when there is less clarity regarding the patent claims at issue and
14 their scope—further undermining an efficient IPR process.

15 74. Any inefficiency that might result from overlap between litigation and IPR
16 proceedings would be better addressed by a stay of the litigation pending the outcome of the IPR.
17 *See, e.g., Bell N. Res., LLC v. Coolpad Techs., Inc.*, No. 18-cv-1783-CAB-BLM, ECF No. 148 (S.D.
18 Cal. Feb. 18, 2020) (after previously denying stay without prejudice while IPR petition was pending,
19 granting stay of litigation after Board decided to institute IPR). Unlike denial of IPR, a stay of the
20 litigation does not risk irreversibly depriving the petitioner of Congress’s preferred forum for
21 resolving an unpatentability dispute.

22 75. The Board’s attempt to justify the *NHK-Fintiv* rule on the ground that it avoids
23 “duplicative costs” by denying IPR when “the court and the parties have invested” substantially in the
24 lawsuit, *Fintiv*, Paper 11 at 9, makes no sense. By focusing on the past investment that has been
25 made in the litigation already, the Board’s explanation is irrational and rests on the fallacy of sunk
26 costs—*i.e.*, “the equivalent of throwing good money after bad, both for the court and for the parties.”
27 *Stryker Spine v. Spine Grp. of Wis., LLC*, 320 F. Supp. 3d 985, 991 (E.D. Wis. 2018). To the extent
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1 that promoting efficiency is relevant to the institution decision at all, the analysis should instead
2 compare the *future* investment needed to complete the lawsuit to the *future* investment needed to
3 conduct IPR—a comparison that will usually favor IPR.

4 **The *NHK-Fintiv* Rule Is Procedurally Invalid**

5 76. The *NHK-Fintiv* rule is a substantive rule that alters the rights and interests of IPR
6 petitioners by permitting the Board to deny institution of IPR based on parallel litigation. In adopting
7 such a rule, the Director was required by both the APA and the AIA to act through notice-and-
8 comment rulemaking. *See* 5 U.S.C. § 553(b), (c); 35 U.S.C. §§ 2(b)(2), 316(a).

9 77. The Director, however, adopted the *NHK-Fintiv* rule without notice-and-comment
10 rulemaking, instead propounding it as a binding rule by designating the *NHK* and *Fintiv* decisions as
11 precedential through a unilateral, internal process that involved no opportunity for public comment
12 and no consideration by the Director of any public input.

13 **COUNT 1**

14 **(Final Agency Action In Violation Of 5 U.S.C. § 706(2)(C))**

15 78. Under the APA, the Court “shall ... hold unlawful and set aside” final agency action
16 found to be “in excess of statutory jurisdiction, authority, or limitations, or short of statutory right.” 5
17 U.S.C. § 706(2)(C).

18 79. The *NHK-Fintiv* rule is final agency action “in excess of statutory jurisdiction,
19 authority, or limitations, or short of statutory right” because it violates the AIA and the Director
20 exceeded his statutory authority in adopting it.

21 80. The AIA’s text and structure make clear that Congress withheld from the Director the
22 authority to deny IPR petitions based on a parallel infringement lawsuit against the IPR petitioner that
23 was served less than one year before the IPR petition was filed. By allowing IPR petitions to be filed
24 at any time within one year after the start of an infringement lawsuit involving the same patent, by
25 allowing IPR to proceed even where the petitioner has filed a counterclaim challenging the patent’s
26 validity, and by designing IPR to serve as an efficient alternative to litigation for eliminating invalid
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1 patent claims, Congress left no room for the Director to otherwise deny a timely IPR petition based
2 on parallel infringement litigation.

3 81. The AIA expressly contemplates that IPR and litigation can proceed simultaneously
4 and specifies how administrative efficiency should be accounted for and best served in that
5 circumstance. The Director has no authority to alter that judgment.

6 82. By authorizing the Board to deny institution of a timely IPR petition based on overlap
7 with pending litigation, the *NHK-Fintiv* rule contravenes the text and structure of the AIA and
8 undermines its purpose and the strength of the patent system.

9 **COUNT 2**

10 **(Final Agency Action In Violation Of 5 U.S.C. § 706(2)(A))**

11 83. Under the APA, the Court “shall ... hold unlawful and set aside” final agency action
12 that is “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.” 5
13 U.S.C. § 706(2)(A).

14 84. The *NHK-Fintiv* rule is final agency action that is “arbitrary, capricious, an abuse of
15 discretion, or otherwise not in accordance with law.”

16 85. For the reasons alleged in Count 1, the *NHK-Fintiv* rule is arbitrary, capricious, and
17 not in accordance with law because it violates the AIA.

18 86. Additionally, the *NHK-Fintiv* rule is arbitrary, capricious, and an abuse of discretion
19 because it requires the Board to engage in substantial speculation as to the likely course of the parallel
20 district court proceeding and because its factors are vague and malleable. As a result, the rule
21 produces irrational, unpredictable, and unfair outcomes, treating similarly situated IPR petitioners
22 differently and depriving some patent infringement defendants of a speedy, efficient, and specialized
23 forum for invalidating the patent at issue.

24 87. The *NHK-Fintiv* rule is also arbitrary, capricious, and an abuse of discretion because it
25 will not achieve its stated purpose of promoting administrative efficiency, and the Board’s contrary
26 explanations are unreasoned and not rationally connected to the facts.

COUNT 3

(Final Agency Action In Violation Of 5 U.S.C. § 706(2)(D))

88. Under the APA, the Court “shall ... hold unlawful and set aside” final agency action that is undertaken “without observance of procedure required by law.” 5 U.S.C. § 706(2)(D).

89. The *NHK-Fintiv* rule is final agency action undertaken “without observance of procedure required by law.”

90. Even if the *NHK-Fintiv* rule were not contrary to law, the Director could not adopt such a rule without notice-and-comment rulemaking. *See* 5 U.S.C. § 553; 35 U.S.C. §§ 2(b)(2), 316(a).

91. The Director propounded the *NHK-Fintiv* rule as a binding substantive rule without notice and comment in violation of the APA.

RELIEF REQUESTED

WHEREFORE, Plaintiffs respectfully request that the Court enter judgment in their favor and:

1. Declare that the *NHK-Fintiv* rule is unlawful;
2. Set aside the *NHK-Fintiv* rule;
3. Permanently enjoin Defendant, and his officers, agents, employees, assigns, and all persons acting in concert or participating with him, from relying on the *NHK-Fintiv* rule or the non-statutory factors it incorporates to deny institution of IPR;
4. Award Plaintiffs their costs and attorney’s fees and expenses as allowed by law; and
5. Provide such other and further relief as the Court deems appropriate.

DATED: August 31, 2020

Respectfully submitted,

By: /s/ Mark D. Selwyn

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** Pro hac vice application forthcoming*

ATTORNEY ATTESTATION

I, Mark D. Selwyn, am the ECF User whose ID and password are being used to file this document. In compliance with N.D. Cal. Civil L.R. 5- 1(i)(3), I hereby attest that concurrence in the filing of the document has been obtained from each of the other signatories.

By: /s/ Mark D. Selwyn
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